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APR 05 2004

OFFICE OF PETITIONS

In re Application of
Douglas A. Collins et al.
Application No. 10/620,273
Deposited: July 15, 2003
Attorney Docket No. 07959.105018 DIV
Title: RADIONUCLIDE LABELING OF
VITAMIN B12 AND COENZYMES
THEREOF

DECISION ON PETITION
UNDER 37 C.F.R. §1.182

BACKGROUND

This is a decision on the "Petition to Accord Filing Date (petition)," and the "Response to Notice of Incomplete Nonprovisional Application (response)," concurrently filed February 3, 2004, which is properly treated as a petition under 37 C.F.R. §1.182, requesting that the above-identified application be accorded a filing date of July 15, 2003, with Figures 1 and 2 (one and two) as part of the original disclosure of the application.

The application was deposited July 15, 2003. However, on December 3, 2003, the Office of Initial Patent Examination (OIPE) mailed a notice stating that the application had NOT been accorded a filing date, and advising applicants that the application appeared to have been deposited without drawings, and that a filing date would be accorded upon the depositing of drawings. The Notice further indicated that a newly executed oath or declaration would be required.

With the instant petition, Petitioner has submitted a copy of Figures 1 and 2 (one and two) and the petition fee. Petitioner has not submitted a newly executed oath or declaration.

With the petition, Petitioner sets forth that a Preliminary Amendment was included on filing which indicates that the instant application is a divisional of 09/626,213 (which issued as 6,613,305 on September 2, 2003), and that the entire disclosure of which was incorporated by

reference^{1,2}. Petitioner concludes that Figures 1 and 2 (one and two) were constructively included on filing, through incorporation by reference.

THE RELEVANT SECTION OF THE MPEP

MPEP 201.06(c) sets forth:

INCORPORATION BY REFERENCE

A. Application NOT Entitled to a Filing Date

Material needed to accord an application a filing date may not be incorporated by reference. Therefore, if a continuation or divisional application as originally filed incorporates by reference material omitted from the application papers, which is needed to accord the application a filing date, the application will not be entitled to a filing date. A petition under 37 CFR 1.182 and the required petition fee, including an amendment submitting the necessary omitted material, requesting that the necessary omitted material contained in the prior application and submitted in the amendment, be included in the continuation or divisional application based upon the incorporation by reference statement, is required in order to accord the application a filing date as of the date of deposit of the continuation or divisional application. An amendment submitting the omitted material and relying upon the incorporation by reference will not be entered in the continuation or divisional application unless a decision granting the petition states that the application is accorded a filing date and that the amendment will be entered.

ANALYSIS

The drawings in question were required to secure a filing date. As such, they may not be incorporated by reference, pursuant to the portion of the MPEP reproduced immediately above. Petitioner properly submitted a petition under 37 C.F.R. §1.182, the required drawings, and the associated petition fee. However, Petitioner has not submitted an amendment requesting that the drawings be entered into the instant application.

Furthermore, Petitioner has not submitted a newly executed oath or declaration, as required by the Notice, and has set forth that such is not required as the drawings do not constitute new matter³. Unfortunately, a new oath or declaration will be required. Pursuant to MPEP §§608.02(h) and 608.04, the Examiner will eventually review these drawings to determine whether they constitute new matter, and if it is determined that they constitute new matter, they will not be entered. As such, it is not within the jurisdiction of the undersigned to determine whether the drawings constitute new matter, and a newly executed oath or declaration is required.

CONCLUSION

For these reasons, the petition under 37 CFR 1.53(b) is dismissed.

1 Response, page 1.

2 It is noted that this Preliminary Amendment has been located in the electronic file, and it does set forth both the continuity and the incorporation by reference.

3 Response, page 1.

Figures 1 and 2 (one and two), submitted with the instant petition, will not be entered.

Any renewed petition must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The renewed petition should include a cover letter entitled "Renewed Petition under 37 CFR 1.182."

The reply to this letter may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶.

The reply should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner. The Petitioner may wish to consider telephoning the undersigned at the number provided below to confirm that the documents were delivered to the undersigned. Please note that the delivery process within the PTO can take as much as three weeks.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding this decision should be directed to Attorney Paul Shanoski at (703) 305-0011

A handwritten signature in cursive script, appearing to read "Patricia Lucas-Bal", is written over the typed name "Jay Lucas".

Jay Lucas
Interim Supervisory Patent Examiner
Office of Petitions
United States Patent and Trademark Office

⁴ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁵ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

⁶ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.